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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------|-------------|----------------------|---------------------------|------------------|
| 10/796,281 | 03/10/2004 | Myong-do Ro | 1793.1012 | 9380 |
| 21171 | 7590 | 03/23/2005 | EXAMINER | |
| STAAS & HALSEY LLP | | | MULVANEY, ELIZABETH EVANS | |
| SUITE 700 | | | ART UNIT | |
| 1201 NEW YORK AVENUE, N.W. | | | PAPER NUMBER | |
| WASHINGTON, DC 20005 | | | 1774 | |

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/796,281

Applicant(s)

RO ET AL.

Examiner

Elizabeth E. Mulvaney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-18 is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6, 7, 9, 19, and 20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 2002/0197441.

The reference discloses an optical recording medium comprising a substrate which is 65-130mm in diameter and 0.4-2.5mm in thickness. These ranges encompass the values claimed. The tilt value is preferably 0.3 degrees. See paragraph [0066].

It is recognized that the specific values for the thickness and diameter of the substrate are not specified in the reference. However, as the ranges disclosed include these points, it would have been obvious to one of ordinary skill in the art to choose the specific points. One would be motivated by the reasoned expectation of obtaining the optimum tilt value.

Claims 1-7, 9, 19, and 20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 2003/0157292.

The reference discloses an optical recording medium comprising substrate having a diameter of 50-100mm (See para [0003], preferably ~40mm, and a thickness of 0.3-1.2mm (See paragraph [0147]).

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It is recognized that the specific values for the thickness and diameter of the substrate are not specified in the reference. However, as the ranges disclosed include these points, it would have been obvious to one of ordinary skill in the art to choose the specific points. One would be motivated by the reasoned expectation of obtaining the optimum dimensional stability as described.

Allowable Subject Matter

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10-18 are allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The art cited disclose minidisks.

Any inquiry concerning this communication should be directed to Elizabeth Evans Mulvaney at (571) 272-1527. The examiner can normally be reached Monday through Thursday from 9:00 AM to 6:00 PM and on alternating Fridays from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached at (571) 272-3186. The fax number for the organization where the application is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information retrieval (PAIR) System. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the

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PAIR System, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

PAIR System, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



Elizabeth Evans Mulvaney
Primary Examiner
Group 1700